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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,953	08/02/2001	Masao Akimoto	P20745	4285
7055	7590	10/05/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			JEAN, FRANTZ B	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/919,953

Applicant(s)

AKIMOTO ET AL.

Examiner

Frantz B. Jean

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/20/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This office action is in response to application for patent titled a communication control apparatus and a communication control method, which was filed on 08/02/01. This application has a foreign priority dated 08/04/00.

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 11/20/01 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Specification***

The abstract of the disclosure is objected to because of a typographical error on line 4 of the abstract that reads "SMPT". It should have been SMTP. Correction is required. See MPEP § 608.01(b).

Claims 3 and 12 are objected to because of the following informalities: Please change "SMPT" to SMTP. Appropriate correction is required.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 9 and 11-12 of copending Application No. 10/034,372. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in both applications are directed to the same concept, which is controlling communication between IFAX and groupware. Furthermore, the claims' language in both applications contains limitations that are similar. Therefore it has been held omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See *in re Karlson*, 136 USPQ 184.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 12 rejected under 35 U.S.C. 102(e) as being anticipated by Piersol et al hereinafter "Piersol" US publication Number 2005/0174593A1.

As per claims 1 and 12, Piersol teaches a system for capturing facsimile data in an electronic document management system that comprises a communication control apparatus, comprising: a first interface section connected to a network that is controlled by a server in accordance with a HTTP protocol; a second interface section connected to an Internet facsimile apparatus; a SMTP processing section that controls communication with the Internet facsimile apparatus in accordance with a SMTP protocol; a HTTP processing section that controls communication with the server in accordance with the HTTP protocol; an email communication section that receives email data from the Internet facsimile apparatus in accordance with the control of said SMTP processing section; a HTML processing section that converts the email data to HTML data; and a HTML communication section that transmits the HTML data to the server in accordance with the control of said HTTP processing section (see paragraphs 0026, 0030, 0042, 0052 and 0059 which disclose explicitly and inherently all the concept and elements of the claim limitations).

As per claim 2, Piersol teaches a communication control apparatus according to claim 1, further comprising: a signal type detection section that detects a type of a signal transmitted via the first interface section, wherein when said signal type detection section detects reception of predetermined signal type from the Internet facsimile apparatus, said HTTP processing section starts controlling communication with the

server in accordance with the HTTP protocol and said SMTP processing section controls communication with the Internet facsimile apparatus in accordance with the SMTP protocol (paragraphs 0026, 0030, 0042, 0052 and 0059).

As per claim 3, a communication control apparatus according to claim 2, wherein said HTTP process section starts controlling a communication with the server in accordance with HTTP protocol when HELO signal, which is a command signal in accordance with the SMTP protocol, is received from the Internet facsimile apparatus (inherent in Piersol; see paragraphs 0026, 0030, 0042, 0052 and 0059).

As per claim 4, Piersol teaches a communication control apparatus according to claim 1, further comprising: an encryption processing section that encrypts the email data received by said email communication section; wherein said HTML processing section converts the email data encrypted by said encryption process section into HTML data (par 0048, lines 20-27).

AS per claim 5, Piersol teaches a communication control apparatus according to claim 4, further comprising: an IC card that stores information necessary for an encryption process by said encryption processing section; and a slot section into which said IC card is insertable; wherein said encryption processing section encrypts email data in accordance with the information stored in said IC card, when said IC card is inserted to

said slot section (par 0048 lines 20-27).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6- 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piersol et al. US Publication Number 2005/0174593A1.

As per claim 6, Piersol teaches a communication control apparatus, comprising: a first interface section connected to a network that is controlled by a server in accordance with a HTTP protocol; a second interface section connected to Internet facsimile apparatus; a HTTP processing section that controls communication with the server in accordance with a HTTP protocol; a HTML communication section that receives HTML data including email data from the server in accordance with the control of said HTTP processing section; a HTML processing section that extracts the email data from the HTML data; and an email communication section that transmits the email data to the Internet facsimile apparatus in accordance with the control of the processing section (see paragraphs 0026, 0030, 0042, 0052 and 0059 which disclose explicitly and inherently all the concept and elements of the claim limitations). However, Piersol does not disclose a POP3 protocol. It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated a POP3 protocol into Piersol IFAX system because it would have facilitated mail transfer and communication in Piersol's.

As per claim 7, Piersol teaches a communication control apparatus according to claim 6, further comprising: a signal type detection section that detects a type of signal transmitted through said first interface section; wherein said HTTP processing section starts communication with the server in accordance with the HTTP protocol and said POP3 processing section controls communication with the Internet facsimile apparatus in accordance with the POP3 protocol when said signal type detection section detects transmission of a predetermined type of the signal from the Internet facsimile apparatus (par 0055; see claim 6 rejection above for POP3).

AS per claim 8, Piersol teaches a communication control apparatus according to claim 7, wherein said HTTP process section starts controlling communication with the server in accordance with HTTP protocol when said signal type detection section receives a signal USER, which comprises a command signal in accordance with the POP3 protocol from the Internet facsimile apparatus (par 0026, 0030, 0042, 0052 and 0059; see rejection of claim 6 regarding User signal and POP3; it must be noted that a USER signal is implicit in POP3).

As per claim 9, Piersol teaches a communication control apparatus according to claim 6, further comprising: a decryption processing section that decrypts encrypted email data when the email data extracted from the HTML data by said HTML processing section is encrypted email data; wherein said email communication section transmits the email data decrypted by said decryption processing section to the Internet facsimile



apparatus (par 0048, 0026, 0030, 0042, 0052 and 0059).

As per claim 10, Pierson teaches a communication control apparatus according to claim 9, further comprising: an IC card that stores information necessary for decryption by said decryption processing section; and a slot section to which said IC card is inserted; wherein said decryption processing section decrypts email data in accordance with the information stored in said IC card when said IC card is inserted to said slot section (par 0048, 0026, 0030, 0042, 0052 and 0059).

As per claim 11, Piersol teaches a communication control apparatus according to claim 10, wherein said IC card stores email address information and said HTML communication section transmits the HTML data corresponding to the email data received to the email address information stored in said IC card when said IC card is inserted in said slot section (0026, 0030, 0042, 0052 and 0059 ).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 571-272-3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571 272 3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frantz Jean



**FRANTZ B. JEAN**  
**PRIMARY EXAMINER**